REMARKS

Reconsideration of this application is respectfully requested.

Claims 1-16 are in the application. Claim 1 has been amended.

The Examiner rejected claims 1-16 under 35 U.S.C. §102(e) as being allegedly anticipated by Lee (U.S. Patent No. 6,694,331). In response to Applicant's previous arguments, the Examiner stated,

> Regarding the Applicant's argument that the Lee reference fails to teach the development of a query based on a portion of said first characteristics of said identified pieces of second intellectual property without the user's involvement, the examiner respectfully disagrees.
>
> Lee discloses at col. 11, lines 23-26 and 35-39, as well as col. 12, lines 19-22 and 26-29, the fact that a query based upon characteristics of identified pieces of intellectual property can be developed automatically.
>
> Furthermore, regarding the issue of whether said query is *executed* without the user's involvement (a limitation which has not yet been argued or claimed by the Applicant), the examiner points out that at col. 12, lines 26-29, Lee discloses that the field-of-search [created from the characteristics of identified pieces of intellectual property] can form a search query to be executed by a local or remote database.
>
> Lee also discloses that the disclosed "user" of the system may be (among other things) a device, system or module, col. 13, line 63 through col. 14, line 2).

At the onset, it is indicated that Claim 1 has been amended to clearly indicate that the steps of "developing" and "searching" are "executed without the user's involvement".

Lee is directed to an apparatus and method of searching and organizing intellectual property information. With reference to Figure 1, the Lee system includes a server 30 and a user

interface 35. The user interface 35 may include one or more display devices and one or more

input devices. Col. 3, ll. 12-17. Individual control modules may be provided within the server

30, including: class search module 310; IP thesaurus module 312; and, field-of-search module

314. See, e.g., col. 3, ll. 1-5. Figure 3 sets forth the operation of the class search module 310.

As set forth at column 6, lines 59-65,

> A user performing a desired search is given access to and able to review the
> different subject headings, titles, and definitions in the classification system to
> locate and select the most pertinent classifications (step 502). Class search
> module 310 receives input data from user interface 35 regarding one or more
> classifications selected by the user.

The selected classifications "are used to define search criteria to be used in searching database 32

for desired intellectual property information (step 504)." Col. 7, ll. 11-13. The user may also

apply other search criteria to the class search module 310, such as keywords, date restrictions,

and Boolean logic operators. Col. 7, l. 63 - col. 8, l. 1.

With respect to the IP thesaurus module 312, this module is "programmed to receive

input data or signals from a user (e.g., via user interface 35) identifying select intellectual

property information to form or otherwise be designated as a source collection or grouping".

Col. 8, ll. 17-21. The user provides the necessary intellectual property information or provides

access to such information to form the source grouping. Col. 8, ll. 30-44. Once the source

grouping is retrieved, the information is reviewed and possibly modified. Col. 8, ll. 56-63.

Thus, with reference to Figure 4, and column 8, line 39 - column 9, line 9, the user iteratively

reviews the retrieved data and enters keywords for additional searching.

The field-of-search module 314 is programmed like the IP thesaurus module to receive input data. Col. 10, ll. 41-45. With reference to Figure 5 and column 11, line 63 - column 12, line 29, the field-of-search module 314 requires user input.

Amended claim 1 is directed to a method for investigating intellectual property related to a reference piece of intellectual property including the steps of: searching a first database to identify pieces of a first intellectual property having predetermined characteristics in common with the reference piece of intellectual property; "developing, executed without the user's involvement, at least one query based on at least a portion of said first characteristics of said identified pieces of first intellectual property"; "searching, executed without the user's involvement, said second database to identify said pieces of second intellectual property satisfying said at least one query"; and "transmitting information related to said identified pieces of second intellectual property to the user."

In contrast to the method of claim 1, Lee does not disclose or suggest a method which conducts a first search and then executes at least one query for a second search without user involvement, with the uncovered results being transmitted to the same user. Lee is concerned with conducting searches to identify potentially relevant intellectual property. See, e.g., col. 1, ll. 50-55. Lee relies on user involvement to determine the search criteria in establishing relevancy. With the subject invention, a search is conducted to identify possibly relevant intellectual property by inputting only once characteristics of a reference piece of intellectual property. Without user involvement, the subject invention entails a search of a first database to generate at

least one query for the search of a second database. Lee requires user involvement to conduct

additional searching.

In the Official Action, the Examiner asserted that Lee discloses automatic development

of a query at col. 11, ll, 23-26 and 35-39, and at col. 12, ll. 19-22 and 26-29. However, the four

cited excerpts refer to generating query information for review by a user for later searching.

Specifically, all four of the cited excerpts refer to the field-of-search module 314. The first two

cited excerpts are taken from a paragraph which starts at col. 11, l. 17. The first line of that

paragraph states that "[a] user presented with a list of such information ... from Field-of-Search

Module 314 may use the list in determining, preparing, formulating, or otherwise creating a

field-of-search". (Col. 11, ll. 17-21). The first excerpt cited by the Examiner states that the

"Field-of-Search Module 314 (and/or other modules) may be used to automatically determine or

suggest a field-of-search" — in any regard, the resulting field-of-search is presented to the user

for consideration. Likewise, the second cited excerpt states that the "Field-of-Search Module

314 may automatically (or manually) create, add, or suggest such search information ... for a

field-of-search." This resulting field-of-search is also presented to the user for consideration.

The third and fourth cited excerpts are found in a paragraph starting at col. 11, l. 63

which describes a possible embodiment of Lee. The described embodiment requires the

establishment of a field-of-search to conduct the search. To select a field-of-search, the user

"selects one or more source groupings". (Col. 11, l. 66). The selected source groupings "may be

displayed or otherwise output for viewing by the user to assist in the creation of a field-of-
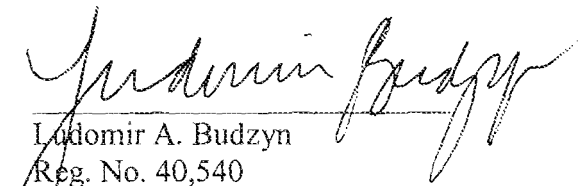
search". (Col. 12, ll. 17-19). With respect to the third excerpt cited by the Examiner, the selected search information "may be statistically analyzed for use in automatically generating, adding, or suggesting a field-of-search." In any regard, the developed field-of-search is presented to the user prior to actual searching. In the fourth cited excerpt, "the field-of-search thus created" refers to the field-of-search already selected by the user. In sum, Lee relies on the field-of-search module 314 to assist a user in developing a field-of-search; however, the ultimate field-of-search is determined by the user.

The Examiner also noted that the "user" in Lee may be "a device, system or module, col. 13, line 63 through col. 14, line 2." Claim 1 requires: 1. a user to input a reference piece of intellectual property; 2. searching as set forth in claim 1 to identify certain pieces of intellectual property; and, 3. transmitting information related to the identified pieces of intellectual property to the user. Thus, the user must be the originator of the search and the final destination for uncovered information. In addition, per claim 1, that same user is not involved in the execution of determing or of conducting the search query. It is unclear how these criteria can be met in Lee. In all embodiments of Lee, it appears that the user is involved in determining and conducting the search query. If the Examiner considers the computing device in Lee to be the "user", the "user" is then involved in the determination and execution of the search query. If the Examiner considers the individual inputting the data to be the "user", the user is also involved in the determination and execution of the search query, as set forth above (i.e., the search queries are always provided to the user for evaluation). It is respectfully submitted that claims 1-16 are patentable over Lee.

Favorable action is earnestly solicited. If there are any questions or if additional information is required, the Examiner is respectfully requested to contact Applicant at the number listed below.

Respectfully submitted,

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